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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,427	04/05/2005	Robert Zhong Lu	102792-433 (11136P3)	6698
27389	7590	10/11/2006	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			DELCOTTO, GREGORY R	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/530,427	<b>Applicant(s)</b> LU, ROBERT ZHONG	
	<b>Examiner</b> Gregory R. Del Cotto	<b>Art Unit</b> 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,8,11-14,23 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,8,11-14,23 and 25-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1, 3, 5, 8, 11-14, 19, 20, 23, and 25-30 are pending. Applicant's arguments and amendments filed 7/25/06 have been entered.

Applicant's election with traverse of Group I, claims 1-6, 8-15, 21-23, and 25, in the reply filed on 7/25/06 is acknowledged. The traversal is on the ground(s) that in Applicant's view, no undue burden is placed upon the Examiner in performing a search of the prior art concurrently dealing with the subject matter of the claims corresponding to Group II. This is not found persuasive because the Examiner maintains that the invention of Group II would require a separate search due to its separate classification thereby placing an undue burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claims 19 and 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/25/06.

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### **Objections/Rejections Withdrawn**

The following objections/rejections as set forth in the Office action mailed 3/8/06 have been withdrawn:

The objections to claims 4 and 10 have been withdrawn.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, 5, 8, 11, 13, and 25-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Charlez et al (US 6,001,795).

Charlez et al teach a microemulsion composition which is especially effective in the removal of oily and greasy soil which contains an anionic detergent, a saturated fatty acid, an unsaturated fatty acid, a solubilizing agent, a perfume having pine like odor, an alkali metal hydroxide, and water. See Abstract. The composition is suitable for cleaning hard surfaces such as plastic, vitreous and metal surfaces having a shiny finish. Also, the compositions exhibit a blooming effect when the composition is added to water in that the formed solution is cloudy. See column 3, lines 10-25. Suitable co-surfactants include ethylene glycol monobutyl ether, propylene glycol monomethyl ether, propylene glycol monoethyl ether, propylene glycol monobutyl ether, etc. See column 8, lines 1-45. Additionally, pH adjusting agents such as sodium hydroxide may be used in amounts up to 4% by weight. See column 10, lines 5-30.

Specifically, Charlez et al teach a composition containing 2.17% sodium dodecyl benzene sulfonate, 2% stearic acid, 2.3% coconut fatty acid, 2.0% isopropanol, 2.5%

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diethylene glycol monobutyl ether, 2.7% potassium hydroxide, 5% perfume and the balance water. See column 11, lines 20-50. Charlez et al disclose the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of Charlez et al anticipate the material limitations of the instant claims.

Claims 1, 3, 5, 8, 11-13, and 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Evers (US 2002/0069901).

Evers teaches a process of cleaning a hard surface with a liquid neutral to alkali composition comprising a polymer and a surfactant system wherein said surfactant system comprises a sulphated or sulphonated anionic surfactant, a neutralizing co-surfactant and an alkoxyated nonionic surfactant. See Abstract. The composition may also comprise up to 2% by weight of a fatty acid. See claims 11-13. Preferred fatty acids include coconut fatty acid. See paras. 143-149. Preferred solvents include benzyl alcohol, ethanol, methanol, etc. See paras. 166. Additionally, the compositions may include perfumes. See paras. 170-175.

Specifically, Evers teaches compositions containing 0.31% sodium paraffin sulphonate, 0.5% sodium hydroxide, 4% butoxy propanol, water, etc. See paras. 228-230. Evers discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of Evers anticipate the material limitations of the instant claims.

Claims 1, 3, 5, 11, and 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 478,086.

'086 teaches low viscosity and high pH disinfecting and bleaching all purpose cleaning compositions in microemulsion form, suitable in both concentrated and diluted forms. See Abstract. Specifically, '086 teaches a composition containing 1% sodium C12-C18 alkyl sulfate, 0.5% coco fatty acid, 0.5% potassium hydroxide, 5% tertiary butanol, 0.3% perfume, 8% aqueous sodium hypochlorite, water, etc. '086 discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of '086 anticipate the material limitations of the instant claims.

Claims 1, 3, 5, 8, 11-13, and 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by WO94/14945. Note that, a translation of this document has been received.

'945 teaches water-based cleaning agents having a pH between 5 and 9 containing 1 to 25% by weight of nonionic or anionic surfactant, 0.1 to 12% by weight of benzyl alcohol, 2-phenoxyethanol, or 2-phenylethanol. See Abstract.

Specifically, '945 teaches a cleaning composition containing 0.05% sodium hydroxide, 0.8% benzene sulfonate, 0.4% coco-fatty acid, , 0.3% perfume, 2% phenoxyethanol, water, etc. See page 12, lines 1-15 and page 10, lines 1-15. '945 discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of '945 anticipate the material limitations of the instant claims.

Claims 23 and 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Evers (US 2002/0069901), EP 478,086, or WO94/14945.

Evers, '086, or '945 are relied upon as set forth above. Note that, the Examiner asserts that the compositions as specifically disclosed by Evers, '086, or '945 would inherently have the same disinfectant and blooming characteristics as recited by the instant claims because the compositions as specifically disclosed by Evers, '086, or '945 contain the same components in the same amounts as recited by the instant claims. Evers, '086, or '945 disclose the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of Evers, '086, or '945 anticipate the material limitations of the instant claims.

Alternatively, even if the broad teachings of Evers, '086, or '945 are not sufficient to anticipate the material limitations of the instant claims, it would have been nonetheless obvious to one of ordinary skill in the art to arrive at the claimed disinfectant and blooming properties of the composition in order to provide the optimum disinfectant and cleaning properties to the composition because Evers, '086, or '945 teach that the amount of required components added to the composition may be varied.

Claims 12 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Charlez et al (US 6,001,795) as applied to the rejected claims above, and further in view of Evers (US 2002/0069901).



Charlez et al are relied upon as set forth above. However, Charlez et al do not teach the use of benzyl alcohol in addition to the other requisite components of the composition as recited by the instant claims.

Evers is relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use benzyl alcohol in the cleaning composition taught by Charlez et al, with a reasonable expectation of success, because Evers teaches the equivalence of benzyl alcohol to propylene glycol monobutyl ether in a similar cleaning composition and further, Charlez et al teach the use of propylene glycol monobutyl ether.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Charlez et al (US 6,001,795) or Evers (US 2002/0069901) as applied to the rejected claims above, and further in view of WO00/49127 or Harrison et al (US 2002/0119902).

Charlez et al or Evers are relied upon as set forth above. However, neither reference teaches the use of propylene glycol phenyl ether in addition to the other requisite components of the composition as recited by the instant claims.

Harrison et al teach aqueous-based cleaning compositions simultaneously featuring disinfecting, low residue deposits and good cleaning characteristics which are particularly useful for cleaning glass and polished hard surfaces. See Abstract. The compositions contain an alkylene glycol solvent such as propylene glycol isobutyl ether, ethylene glycol butyl ether, propylene glycol phenol ether, etc. See para. 34.

'127 teaches hard surface cleaning and disinfecting compositions containing a synergistic combination of a quaternary ammonium compound and an alkoxyated quaternary ammonium compound. See Abstract. Suitable solvents include propylene glycol isobutyl ether, ethylene glycol butyl ether, propylene glycol phenyl ether, etc. See page 24, lines 1-20.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use a solvent such as propylene glycol phenyl ether in the compositions taught by Charlez et al or Evers, with a reasonable expectation of success, because Harrison et al or '127 teach the equivalence of propylene glycol butyl ether to propylene glycol phenyl ether in a similar cleaning composition and further, Charlez et al or Evers teach the use of propylene glycol butyl ether.

Claim 23 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Charlez et al (US 6,001,795).

Charlez et al are relied upon as set forth above. Note that, the Examiner asserts that the composition as specifically disclosed by Charlez et al would inherently have the same disinfectant characteristics as recited by the instant claims because the composition as specifically disclosed by Charlez et al contain the same components in the same amounts as recited by the instant claims. Charlez et al discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of Charlez et al anticipate the material limitations of the instant claims.

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Alternatively, even if the broad teachings of Charlez et al are not sufficient to anticipate the material limitations of the instant claims, it would have been nonetheless obvious to one of ordinary skill in the art to arrive at the claimed disinfectant properties of the composition in order to provide the optimum disinfectant and cleaning properties to the composition because Charlez et al teach that the amount of required components added to the composition may be varied.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 5, 8, 11-14, 23, and 25-30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12, 15, 16, 29, and 31 of copending Application No. 10/530433, claims 1-20 of 10/530372, and claims 1-5, 10-21, 24, and 25 of 10/530926. Although the conflicting

claims are not identical, they are not patentably distinct from each other because claims 1-12, 15, 16, 29, and 31 of copending Application No. 10/530433, claims 1-20 of 10/530372, and claims 1-5, 10-21, 24, and 25 of 10/530926 encompass the material limitations of the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition, having the specific disinfectant and blooming properties, containing an anionic surfactant, alkali metal hydroxide, soap, solvent, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims, because claims 1-12, 15, 16, 29, and 31 of copending Application No. 10/530433, claims 1-20 of 10/530372, and claims 1-5, 10-21, 24, and 25 of 10/530926 suggest a composition, having the specific disinfectant and blooming properties, containing an anionic surfactant, alkali metal hydroxide, soap, solvent, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

With respect to Charlez, Evers, EP 478086, and '945, Applicant states that each of the documents are completely silent as to any germicidal efficacy or of any germicidal benefit provided by those compositions. In response, note that, the Examiner maintains that each of Charlez, Evers, EP 478086, and '945 would inherently teach compositions having the same germicidal efficacy as recited by the instant claims because Charlez,

Evers, EP 478086, and '945 specifically disclose compositions containing the same components in the same amounts as recited by the instant claims. Note that, the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer. Once a reference teaching a product appearing to be substantially identical is made the basis of a rejection, and the Examiner presents evidence or reasoning tending to show inherency, the burden shifts to the applicant to show and unobvious difference. See MPEP 2111 and 2111.01.

With respect to the provisional obviousness type double-patenting rejections, Applicant states that since the instant claims have not been allowed, this rejection is premature. In response, note that, a full and complete Office action includes all potential rejections including provisional obviousness type double-patenting rejections. Thus, the Examiner assert that these rejections are not premature.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571-272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gregory R. Del Cotto  
Primary Examiner  
Art Unit 1751

GRD  
October 2, 2006